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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,353	08/17/2001	Herbert Bachler	33891	4874

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EXAMINER

FOREMAN, JONATHAN M

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 01/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

HCT

Office Action Summary

Application No.

09/932,353

Applicant(s)

BACHLER ET AL.

Examiner

Jonathan ML Foreman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/18/02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13 - 35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13 - 29 and 33 is/are rejected.
- 7) ☒ Claim(s) 30 - 32, 34 and 35 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 November 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claims 30 – 32, 34 and 35 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim because they are dependent on two claims simultaneously. See MPEP § 608.01(n). Accordingly, the claims 30 – 32, 34 and 35 have not been further treated on the merits.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the removable attachment (Claims 18 and 21), the coil extending perpendicular and in any plane between 0° and 180° relative to the magnet (Claims 24 and 25), and the adjustable positioning (Claims 26 and 27) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. Claims 18, 21, 26 and 27 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not describe how the magnet can be removeably attached to the promontory or how the magnet can be positioned on the promontory in an adjustable fashion.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 13, 14 and 19 – 26 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,606,329 to Hough.

In reference to claim 13, Hough discloses an implanted hearing aid with at least one permanent magnet (50) (Figure 8) in the area of the middle ear as well as one coil adapted for placing in the area of the middle ear (37, Figure 3), the permanent magnet (50) is shown positioned on the promontory.

In reference to claim 14, Hough shows the coil (37) being adapted for placing in the area of the ossicle chain.

In reference to claim 19, Hough shows the permanent magnet being one of a circular, oval, square, or rectangular design (Figure 6).

In reference to claims 20, 21 and 26 Hough discloses the permanent magnet (50) being adapted to be solidly attached to the promontory (Col. 7, lines 30 – 37). Because of the clip structure associated with the magnet as shown in Figure 6, the magnet is adapted to be removeably attached or adjustable.

In reference to claim 22, it can be seen in Figure 3, that the coil (37) has a circular design (Col. 5, lines 67 – 68).

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In reference to claims 23 – 25, the coil disclosed by Hough is considered by the examiner to extend in a plain parallel, perpendicular, and between 0° and 180° relative to the magnet (Figure 8) in that the examiner can define the plain of the coil in any manner.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 13 – 18, 28, 29 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perkins '975.

Perkins discloses the claimed invention (Col. 1, lines 40 – 52) except for the magnet is positioned on the tympanic membrane and the coil is positioned on the promontory. It would have been obvious to one having ordinary skill in the art at the time the invention was made to place the magnet as disclosed by Perkins on the promontory and the coil as disclosed by Perkins on the tympanic membrane, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167. The reversal of components in a prior art reference, where there is no disclosed significance to such reversal, is a design consideration within the skill of the art. *In re Gazda*, 219 F.2d 449, 104 USPQ 400 (CCPA 1955); *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950). In the present case, reversing the positioning of the magnet and coil as disclosed by Perkins does not affect the manner in which the device operates.

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Furthermore, it is well established that a recitation with respect to the manner in which an apparatus is intended to be employed, i.e., a functional limitation, does not impose any structural limitation upon the claimed apparatus which differentiates it from a prior art reference disclosing the structural limitations of the claim. *In re Pearson*, 494 F.2d 1399, 181 USPQ 641 (CCPA 1974); *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 136 USPQ 458 (CCPA 1963). Where the prior art reference is inherently capable of performing the function described in a functional limitation, such functional limitation does not define the claimed apparatus over such prior art reference, regardless of whether the prior art reference explicitly discusses such capacity for performing the recited function. *In re Ludtke*, 441 F.2d 660, 169 USPQ 563 (CCPA 1971). In addition, where there is reason to believe that such functional limitation may be an inherent characteristic of the prior art reference, Applicant is required to prove that the subject matter shown in the prior art reference does not possess the characteristic relied upon. *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990); *In re King*, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986); *In re Ludtke*, 441 F.2d at 664, 169 USPQ at 566 (CCPA 1971). In the present case, the magnet and coil as disclosed by Perkins are capable of being placed at locations within the middle ear as desired.

Allowable Subject Matter

6. Claim 27 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant has traversed the rejections to claims 1 and 2 under 35 U.S.C. § 102(b) as being anticipated by Hough (U.S. Patent No. 4,606,329). Applicant has pointed out that Hough teaches an

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“electromagnet signal transmitting means 36” that is adapted to be implanted in the temporal bone outside the middle ear. The examiner is in agreement with the applicant. However, the close proximity of the transmitting means (36) in the temporal bone with the middle ear cavity is considered by the examiner to meet the limitation “in the area of the middle ear” as stated in claims 13 and 14.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (703)-305-5390. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max F Hindenburg can be reached on (703)308-3130. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-308-0758 for regular communications and (703)-308-0758 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-0858.



JMLF

January 24, 2003



SAMUEL G. GILBERT
PRIMARY EXAMINER